

REMARKS

With the entry of this Amendment, claims 5-20 will be pending in this patent application. Claims 5-16, drawn to a non-elected species, stand withdrawn from further consideration.

In this paper, Applicant is canceling claims 1-4.

Applicant submits that the arguments presented in this paper show that independent claim 17 and dependent claims 18-20 are allowable. Accordingly, Applicant respectfully requests that the amendments to the claims presented herein be entered. Alternatively, since the amendments to the claims presented herein reduce the issues to be considered on appeal, Applicant requests that the amendments to the claims be entered upon the filing of an appeal, if an appeal should become necessary.

PRIOR ART REJECTION I

Claim 1 stands rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over US 6319150 B1 (Werner et al.).

This rejection is rendered moot by the cancellation of claim 1.

PRIOR ART REJECTION II

Claims 2-4 stand rejected under 35 USC § 103(a) as being unpatentable over Werner et al.

This rejection is rendered moot by the cancellation of claims 2-4.

PRIOR ART REJECTION III

Claims 17-20 stand rejected under 35 USC § 103(a) as being unpatentable over US 4432549 (Zebelean). Applicant respectfully traverses this rejection.

The Examiner characterizes the Zebelean patent as disclosing "applicant's basic claimed invention and includes a thinned striking face region in areas above the geometric center of the striking face."

Applicant does not agree with the Examiner that Zebelean discloses "applicant's basic claimed invention." In the golf club head defined by Applicant's claim 17, a maximum resilience

point in the hitting surface of the club head is displaced from the center of the hitting surface. More particularly, the range of locations of the maximum resilience point is specified in the claim in relation to the center of the hitting face. Claim 17 also recites measurable properties of the center and the maximum resilience point of the hitting face, as determined by a known test performed at the center and at the maximum resilience point.

At most, Zebelean discloses a hollow metal golf club head with a club face, or hitting surface, that becomes thinner toward the crown of the head. See, for example the club head illustrated in Fig. 12. As disclosed in the Zebelean patent, the purpose of this club face configuration is to position more of the club head mass toward the sole of the club head. See, for example, column 6, lines 25-29 and 43-46.

The Examiner concedes that "Zebelean does not disclose the precise, claimed points of maximum resiliency." In fact, there is no discussion whatsoever in Zebelean of flexing of the club face, much less a discussion of a maximum resilience point at locations on the club face that are specified in relation to the center of the club face.

The Examiner adds, "no criticality has been established by the applicant for applying the claimed range of "y" and "x" values." To the contrary, Applicant has shown, from the results of tests reported in the specification of this application, that golf club heads having properties recited in claim 17 exhibit superior performance in terms of flight distance when compared to golf club heads without the claimed properties.

The Examiner also adds, "The claimed value of (t2 - t1) is not deemed patentable, as the claimed value is simply set forth so that the club head may conform to a known pendulum test result set." Applicant disagrees. Applicant is not asserting that (t2 - t1) is patentable. Applicant is asserting that the club head with a combination of properties, as recited in claim 17, including properties that can be measured by applying a known test, is patentable over the prior art.

On page 6 of the outstanding Office Action, in response to Applicant's arguments relating to other claims and other prior art, the Examiner says that the claims "never define what the extent of the hitting surface is." Applicant submits that the term "hitting surface," like "club face" or "striking face," has a clear, common and accepted meaning when applied to a golf club head and does not introduce ambiguity into the claim. On page 7, the Examiner notes, "applicant has

indicated that the USGA test does not apply to points outside the clubface center. If this is the case, then it is inaccurate to compare a claimed value of $(t_2 - t_1)$ for areas outside the clubface center with results of the test, when the test only dictates values for $(t_2 - t_1)$ on the center of the hitting surface." The Examiner apparently regards the known USGA pendulum test as being capable of measuring properties of a club face. Applicant contends that the prior art *does not disclose* using the USGA test to measure properties of the club face away from the center. This does not mean that the test *cannot be used* to measure properties of a club face away from the center. Moreover, Applicant submits that the absence of prior art disclosures of using the USGA test at locations away from the center of the club face points to the unobviousness of the combination of properties of Applicant's club head as recited in claim 17.

In view of the foregoing observations, Applicant submits that the disclosure in Zebelean cannot properly serve as a basis for rejecting claims 17-20 under 35 USC § 103(a).

CONCLUSION

In view of the observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections stated in the outstanding Office Action and recognize all of the pending claims as allowable.

If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number provided below, so that these matters can be resolved expeditiously.

Application No. 10/791,845
Amendment dated January 31, 2007
After Final Office Action of October 31, 2006

Docket No.: 3673-0170P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 31, 2007

Respectfully submitted,

By Andrew D. Meikle
s/ Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant